

REMARKS

Applicant notes that the Office continues to send the correspondence for the above referenced application to Applicant's attorney's old address. Please note the address at the bottom of the remarks and send all further correspondence with regard to this application to such place there.

Claims 1-37 were presented for examination. Claims 1-10, 13-15, 17-26 and 28-37 were rejected and Claims 11, 12, 16 and 27 were objected to.

Claims 28-31, 33, 34 and 36 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,842,516 to Jones. In response, Applicant has argued in the past and still maintains the Jones 5,842,516 does not show an exit nozzle chamber. Item 29 of Jones is only an insert to abate erosion. Applicant does not understand where the Office is finding any reference for an "exit nozzle chamber" in Jones. It doesn't exist. Jones fails to disclose that element. In addition, Jones specifically discloses that the tubes 25 are perforated 26 and not un-perforated for conduits as set out in the suggestion by the Office on page 2 of the Office Action. Applicant's shunt tubes 25 are not perforated to prevent the gravel from going to places it shouldn't. Further, shunt tubes 25 are exterior to the screen rather being between the base pipe and the screen. In addition, Claims 29-31, 33, 34 and 36 are dependent on claim 28 which should now be in allowable form. Therefore, Claims 28-31, 33, 34 and 36 should be in allowable form.

Claims 1-10, 18-21, 23 and 24 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,515,915 to Jones *et al.* in view of U.S. Patent No. 5,842,516 to Jones. In response, Jones' 915 discloses a non-alternate path but generally shows just a straight pumping down path for the gravel. Manifold 55 is really only supplied at the first or top joint from the crossover sub to the shunt tubes. Applicant's invention has the manifold between joint to joint, see for example Claim 13. Further, one section of the exit nozzle chambers are not shown in the combination of Jones and

Jones, nor is the shunt tube positioned inside the annulus shown, all of which is in Claim 1 of Applicant's invention. Further, the exit nozzle chambers connected to the shunt tube as in Claim 1 are not shown in the combination of Jones and Jones. The multiple exit ports circumferentially spaced around the nozzle chambers are not shown in the combination of Jones and Jones. See also the structure of Claim 8 which is nowhere shown in the combination of Jones and Jones. See also Claim 9. See also Claim 18 and its references to the exit nozzle chamber. Also see Claim 19 dealing with the un-perforated flow conduits. Further, see Claim 23 dealing with the flow paths spaced radially around the base pipe within the tube annulus. In addition, Claims 2-10 depend on Claim 1 and should therefore be in allowable form. Claims 19-21, 23 and 24 are dependent on Claim 18 and therefore should be in allowable form.

Claims 13-15, 17, 22, 25 and 26 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,515,915 to Jones *et al.* in view of U.S. Patent No. 5,842,516 to Jones and US Publication No. 2004/0140089 to Gunnerod. In response, Jones '915 does not have a member or manifold 55 having an interior open to and facing the shunt tube plus forming an annulus for fluid flow. It does not form an annulus for fluid flow. Further, Jones '915 does not have outlets 33 alternating with outer surface section. Jones '915 has the shunt tubes running the whole length of the device. There is no alternating of the screen and the outlets in Jones '915. Any attempt to have alternation in Jones would have gravel flowing throughout the interior which would be not operable. Further, as set out above Jones '516 does not have exit nozzle chambers or inserts at outlets 26. Further, the Office has suggested overcoming rejection under 35 U.S.C. 102(e) for prior art. The Applicant is confused as to what the Office would want. On page 4 line 3 of the Office Action after citing 35 U.S.C. 102(e), the Office then states that the rejection under 35 U.S.C. 103(a) might be overcome in several ways. Applicant asked whether the Office is stating that citing under 35 U.S.C.

102(e) to achieve a 35 U.S.C. 103(a) rejection is the use made of the publication. In addition, the application and reference are currently owned by the same party and there was joint inventorship involved. Therefore, Claims 13-15, 17, 22, 25 and 26 should be in allowable form.

Claims 32 and 35 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,842,516 to Jones in view of U.S. Publication No. 2004/0140089 to Gunnerod. In response, first, Jones '516 does not show exit nozzle chambers. This is fundamental to the invention of those Claims. The round conduits and exit nozzle chamber is not shown in Jones '516. As with Claim 35, Claim 35 is dependent on Claim 28. Claim 28 presumes an exit nozzle chamber which is not shown in Jones '516. Claims 32 and 35 depend on Claim 28 which should now be in allowable form as discussed above. Therefore, Claims 32 and 35 should be in allowable form. In addition, Applicant has discussed the issue of terminal disclaimer and asked for clarification.

Claims 28 and 37 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,842,516 to Jones *et al.* in view of U.S. Patent No. 5,515,915 to Jones. In response, as discussed, with regard to Claims 28 and 37 in this case, the exit nozzle chambers are not shown in either of the Jones patents. Therefore, the fundamental assumptions under which this rejection was made does not exist. Therefore, Claims 28 and 37 should be in allowable form.

Claims 11, 12, 16 and 27 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In response, Claims 11 and 16 were placed in independent form and Claims 12 and 27 depend only on them respectively. Therefore, Claims 11, 12, 16 and 27 should be in allowable form.

In commenting on the references and in order to facilitate a better understanding of the differences that are expressed in the claims, certain details of distinction between same and the

present invention have been mentioned, even though such differences do not appear in all of the claims. It is not intended by mentioning any such unclaimed distinctions to create any implied limitations in the claims. Not all of the distinctions between the prior art and applicant's present invention have been made by applicant. For the foregoing reasons, applicant reserves the right to submit additional evidence showing the distinction between applicant's invention to be unobvious in view of the prior art.

The foregoing remarks are intended to assist the Office in examining the application and in the course of explanation may employ shortened or more specific or variant descriptions of some of the claim language. Such descriptions are not intended to limit the scope of the claims; the actual claim language should be considered in each case. Furthermore, the remarks are not to be considered to be exhaustive of the facets of the invention which are rendered patentable, being only examples of certain advantageous features and differences which applicant's attorney chooses to mention at this time.

The Commissioner is to charge any deficiencies or overpayment to Deposit Account No. 50-2413 of Adams and Reese, LLP.

Please send all future correspondence regarding the above-referenced application to the undersigned at the address appearing below.

Reconsideration of the application as amended and allowance thereof are requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'David M. Ostfeld', is written over a horizontal line.

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